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8 UNITED STATES DISTRICT COURT
9 SOUTHERN DISTRICT OF CALIFORNIA
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11 BLAST MOTION, INC.,
12 a California corporation,

Plaintiff,

13 v.

14 ZEPP LABS, INC.,
15 a Delaware corporation,

16 Defendant.
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Case No.: 3:15-cv-00700-JLS-NLS

**ORDER DETERMINING JOINT
MOTION FOR DISCOVERY
DISPUTE NO. 2**

(Dkt. No. 41)

19 Before the Court is the parties' Joint Motion for Determination of Discovery
20 Dispute No. 2. Defendant Zepp Labs, Inc. ("Zepp") requests the Court to order Plaintiff
21 Blast Motion, Inc. ("Blast Motion") to provide further responses to Interrogatory
22 Numbers 16 and 17. Blast Motion opposes. For the reasons explained below, the Court
23 **GRANTS** Zepp's request to compel further responses to these interrogatories.

24 **I. Relevant Background**

25 The parties are in the discovery phase of this patent infringement action. On
26 October 22, 2015, Zepp served interrogatories to Blast Motion. On November 25, 2015,
27 Blast Motion served its objections and responses. At issue are Interrogatory Numbers 16

1 and 17. Zepp's Interrogatory No. 16 states: "For each limitation of each asserted claim
2 identified in Section VI of Your Disclosure of Asserted Claims and Infringement
3 Contentions ... provide a chart that identifies the section, by column and line number,
4 from the earliest filed patent application which You contend supports and/or describes the
5 subject matter disclosed in the limitation." (Dkt. No. 41 at 2.) Blast Motion asserted a
6 number of objections and responded by referring to each patent or patent application
7 related to its asserted patents. (Id. at 3.)

8 Zepp's Interrogatory No. 17 states: "For each version of the Accused Blast Motion
9 Products identified in Section VII of Your Disclosure of Asserted Claims and
10 Infringement Contentions ... provide a claim chart that identifies which features or
11 functionalities of the product practices or embodies each of the limitations of each
12 asserted claim of the Blast Motion Asserted Patents." (Dkt. No. 41 at 3.) Blast Motion
13 asserted a number of objections and responded by referring to each of its asserted patents
14 and the publicly available Blast Motion products. (Id.)

15 Zepp contends Blast Motion's responses are insufficient because Blast Motion
16 knows the basis for its assertion of priority dates and how its products practice each
17 limitation of its asserted patents. Blast Motion contends its responses are sufficient, and
18 Zepp's requests for further information are premature and overly burdensome. The
19 parties met and conferred and were unable to resolve the dispute, and thus sought judicial
20 intervention.

21 **II. Discussion**

22 Under Federal Rule of Civil Procedure 26(b)(1), a party "may obtain discovery
23 regarding any nonprivileged matter that is relevant to any party's claim or defense and
24 proportional to the needs of the case, considering the importance of the issues at stake in
25 the action, the amount in controversy, the parties' relative access to relevant information,
26 the parties' resources, the importance of the discovery in resolving the issues, and
27 whether the burden or expense of the proposed discovery outweighs its likely benefit."

1 Fed. R. Civ. P. 26(b)(1). Federal Rule of Civil Procedure 33(a)(2) pertains to
 2 interrogatories that seek an opinion or contention related to the facts or the legal
 3 application of those facts. This Rule provides that an “interrogatory may relate to any
 4 matter that may be inquired into under Rule 26(b). An interrogatory is not objectionable
 5 merely because it asks for an opinion or contention that relates to fact or the application
 6 of law to fact, but the court may order that the interrogatory need not be answered until
 7 designated discovery is complete, or until a pretrial conference or some other time.” Fed.
 8 R. Civ. P. 33(a)(2). Rule 33(d) provides that a party has the option to answer an
 9 interrogatory by specifying records “[i]f the answer to an interrogatory may be
 10 determined by examining, auditing, compiling, abstracting, or summarizing a party's
 11 business records ..., and if the burden of deriving or ascertaining the answer will be
 12 substantially the same for either party.” Fed. R. Civ. P. 33(d). With these standards in
 13 mind, the Court turns to the substance of the parties’ dispute.

14 **1. Interrogatory No. 16**

15 Zepp seeks information from Blast Motion about what disclosures in earlier patent
 16 applications support Blast Motion’s claim to a priority date of August 26, 2010 for each
 17 of the five patents-in-suit. Information about whether Blast Motion is entitled to the
 18 claimed priority date is an important threshold issue because it will determine which
 19 references qualify as prior art. *McKesson Info. Solutions v. Epic Sys.*, 242 F.R.D. 689,
 20 691-92 (N.D. Ga. 2007).

21 Zepp contends Blast Motion’s response is insufficient because Blast Motion has
 22 the burden to support its entitlement to a priority date. Zepp contends this is particularly
 23 so because Zepp identified 24 prior art references between August 26, 2010 and
 24 September 8, 2014. Zepp avers these references render Blast Motion’s patents invalid
 25 unless Blast Motion can prove it is entitled to the earlier priority date. Zepp also argues
 26 Blast Motion cannot rely on Rule 33(d) to simply reference certain documents in
 27 response because only Blast Motion is familiar with its basis for asserting the later filed

1 continuation-in-part patents have an August 26, 2010 priority date, and therefore the
2 burden is uneven. (Dkt. No. 51 at 6-7, *citing Mancini v. Ins. Corp.*, 2009 US Dist.
3 LEXIS 51321, *9 (S.D. Cal. June 18, 2009); *Laryngeal Mask Co. v. AMBU A/S*, 2009
4 U.S. Dist. Lexis 133152, *5 (S.D. Cal. Feb. 13, 2009). Zepp also contends the request is
5 not overly burdensome to Blast Motion because it must have already done the work to
6 ascertain the basis for asserting its entitlement to the claimed priority date.

7 Blast Motion contends its response is sufficient because it provided the priority
8 date as well as the basis for it by referring to the particular patent applications. In
9 support, Blast Motion points to its infringement contentions responses that provided
10 information regarding priority dates per Patent Local Rule 3.1(f). Blast Motion also
11 contends it is not absolutely required to prove priority because Zepp must first come
12 forward with invalidating prior art to prove invalidity. If Zepp does so, then Blast Motion
13 must then show the prior art does not actually invalidate the patent or is not prior art
14 because the asserted claim is entitled to an earlier priority date. (Dkt. No. 41 at 12.)

15 As explained below, the Court concludes Zepp has demonstrated the information
16 sought is relevant and proportional to the needs of the case, and that Blast Motion's
17 objections are not justified. While Zepp may first need to come forward with
18 invalidating art, and even though Blast Motion can show the prior art either does not
19 invalidate the patent or that it is not prior art because the claim is entitled to an earlier
20 priority date, this does not affect Zepp's right to discover this information. *See generally,*
21 *McKesson Info. Solutions v. Epic Sys. Corp.*, 242 F.R.D. 689, 692 (N.D. Ga. 2007)
22 ("Nowhere in the Federal Rules of Civil Procedure is it required that a party who carries
23 the ultimate burden on an issue at trial must establish a *prima facie* case before it is
24 entitled to discover information the other party may use to rebut the *prima facie* case.
25 Quite the opposite, the rules contemplate that a party receive this information up front,
26 during discovery, so that when the time comes to discharge its burden it has the
27 ammunition necessary to do so.") Because discovery as to the priority date is relevant to
Zepp's defense and its assessment of prior art, and because the Federal Rules do not

1 restrict the scope of discovery based on which party bears the burden of establishing an
2 issue in later proceedings, the Court finds Zepp's request both relevant and proportional
3 to the needs of the case.

4 Thus, the parties' dispute hinges on whether the discovery sought is premature and
5 unduly burdensome. The Court first notes that Zepp's reliance on the Court's prior
6 orders in *Mancini* and *Laryngeal* regarding burden do not shed much light here because
7 those cases presented dissimilar circumstances. Indeed, Blast Motion appropriately
8 distinguished those cases. (Dkt. No. 41 at 11-12 (*Mancini* and *Laryngeal* distinguishable
9 because Blast Motion did not rely on entire universe of documents or numerous cited
10 documents; rather, Blast Motion cites to its patents and patent applications.))

11 Blast Motion points to a recent case out of a Virginia district court, *Univ. of Va.*
12 *Patent Found. v. Gen. Elec.*, 2015 WL 4878880 (W.D. Va. Aug. 14, 2015) for its
13 contention that the request is premature and overly burdensome. In that case, invalidity
14 contentions had not yet been served, and the court found the claims were many more than
15 will actually be contested at the close of discovery and more than contested after
16 defendant submitted its invalidity contentions. *Id.* at *4. The court reasoned that a
17 contention interrogatory seeking priority date discovery was not fundamentally improper,
18 but that the interrogatory was premature and burdensome in light of the status of the
19 litigation. *Id.* at *4-5. In contrast here, this case is further along in the discovery process.
20 Blast Motion and Zepp have served their infringement contentions, invalidity
21 contentions, and their amended invalidity contentions, and claims construction will occur
22 in less than two months.

23 The circumstances presented here are more akin to a recent case from this District,
24 *Odyssey Wireless v. Apple*, where the court compelled further responses to a contention
25 interrogatory regarding priority date discovery. *Id.*, 15cv1735-H (RBB). In *Odyssey*
26 *Wireless*, the defendants moved the court to compel further responses to interrogatories,
27 including a contention interrogatory that sought the basis for the plaintiff's claim it was
entitled to the filing date of the first provisional application. The parties in *Odyssey* were

1 in a similar posture to this case – i.e., the parties had served their infringement and
2 invalidity contentions, and were nearing claims construction at the time the court ruled on
3 the defendants’ motion to compel. (Dkt. No. 137 at 6-7.) The District Judge, although
4 acknowledging *University of Virginia*, granted the defendants’ motion to compel further
5 responses. (Dkt. No. 139, Dkt. No. 140 at 19.) The court reasoned that the plaintiff
6 needed to provide the facts to support its claim to priority and it is fair for the defendants
7 to know how the plaintiff claims priority. (Dkt. No. 140 at 7, 20.) The court further
8 reasoned that this District is a “lay all the cards on the table” District as evidenced by the
9 Local Rules, so that everyone has information up front. (Id. at 12.) The court also
10 determined this to be helpful so the parties are not pushing off responses to these
11 interrogatories, which would be useful for all parties to properly evaluate the case, until
12 the expert reports at nearly the end of discovery when the parties are preparing to file
13 their dispositive motions and preparing for trial. (Id.) This Court finds the District
14 Judge’s analysis in *Odyssey* persuasive. Accordingly, this Court concludes Zepp’s
15 interrogatories are neither premature nor unduly burdensome and further responses are
16 warranted.

17 Accordingly, the Court **GRANTS** Zepp’s request to compel a further response to
18 Interrogatory No. 16. To the extent Blast Motion prefers to prepare its response in a
19 format other than chart form, it may do so. The Court further encourages the parties to
20 confer about potentially limiting the number of asserted claims and prior art references at
21 this juncture.

22 **2. Interrogatory No. 17**

23 Zepp asks Blast Motion to identify how its products embody its asserted patent
24 limitations. Zepp contends Blast Motion has greater access to its inventors and
25 developers of its products, and so Zepp faces a “substantially greater” burden to
26 determine how Blast Motion’s own products embody the claims of Blast Motion’s
27 patents. (Dkt. No. 41 at 8-9.) Zepp also contends it needs this information because Blast
Motion seeks permanent injunctive relief and will need to prove it practices the asserted

1 patents and suffers irreparable harm. Thus, Zepp argues, it wants to know the basis for
2 Blast Motion's assertion that its products embody its asserted claims. (Dkt. No. 41 at 9.)

3 In its response to the interrogatory, Blast Motion referred to the patents themselves
4 and to publicly available Blast Motion products under Rule 33(d). Blast Motion argues it
5 is not required to provide any further response because it is unnecessarily burdensome.
6 Blast Motion argues Zepp can understand Blast Motion's positions based on the
7 information already given and many of its claim limitations are not highly technical such
8 that Zepp should be able to ascertain the information itself. (Dkt. No. 41 at 15.)

9 The Court concludes the case law Zepp cited, *Fresenius Medical Care Holding*
10 *Inc. v. Baxter Intern., Inc.*, supports its argument that it is entitled to further response to
11 this interrogatory. *Id.*, 224 F.R.D. 644, 650 (N.D. Cal. 2004).¹ In *Fresenius Medical*
12 *Care*, the court granted a motion to compel further responses as to dates of conception
13 and reduction to practice of each asserted patent claim. The *Fresenius* court found that
14 the responding party's reliance on Rule 33(d) by referencing documents was inadequate
15 because the burden of deriving an answer was not substantially the same for both parties.
16 Rather, the burden was lower for the responding party because it had access to its own
17 inventors and developers of its products. *Id.*, 224 F.R.D. at 650. So too here. Blast
18 Motion nonetheless contends *Fresenius* is distinguishable because there the request was
19 tailored to a discrete issue for which the plaintiff had exclusive control. This Court does
20 not interpret *Fresenius* so narrowly, and Blast Motion does not explain how the discovery
21 request considered in that case could be interpreted so narrowly.

22 Additionally, it makes little economic sense for Zepp to reverse engineer the
23 products in an effort to determine how Blast Motion claims its own products practice the
24 claims of the asserted patents. Certainly, the information is uniquely within Blast

25 ¹ The other cases cited by Zepp are *Audatex N. Am. Inc. v. Mitchell Int'l, Inc.*, 2014 U.S.
26 Dist. LEXIS 141426, *20-21 (S.D. Cal., Oct. 3, 2014) and *Facedouble, Inc. v. Face.com, Inc.*, 2014 U.S.
27 Dist. LEXIS 19245, *6 (S.D. Cal., Feb. 13, 2014). Those cases are inapposite because they pertain to
requests for specific references to source code and Zepp does not seek source code citations. (Dkt. No.
41 at 9.)


1 Motion's control. It must be provided now. Accordingly, the Court **GRANTS** Zepp's
2 request to compel a further response to Interrogatory No. 17.

3 **III. Conclusion**

4 For the forgoing reasons, **IT IS ORDERED** that Blast Motion must provide
5 further responses to Zepp's Interrogatory Numbers 16 and 17.

6 **IT IS SO ORDERED.**

7 Dated: March 2, 2016

A handwritten signature in cursive script, reading "Nita L. Stormes", written over a horizontal line.

8 Hon. Nita L. Stormes
9 United States Magistrate Judge
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